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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,773	08/16/2001	Yasuhisa Nakajima	SONYJP 3.0-198	2539

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EXAMINER
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TOPGYAL, GELEK W

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/930,773

Applicant(s)

NAKAJIMA ET AL.

Examiner

Gelek Topgyal

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1- 3, and 7-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Hirota.

Regarding claim 1, Nakajima teaches an information recording apparatus for recording new contents onto a recording medium, comprising:

- a recording unit operable to record new contents onto the recording medium (Hirota teaches in col. 4, lines 19-21 of a Hard Disk Drive (HDD) 119 unit that is able to record new broadcast programs);
- a notification unit operable to send a notification to an information processing terminal regarding a recording capacity of the recording medium (In col. 5, lines 14-18, Hirota teaches of a processor 114 that displays a notification to the user);
- a receiver operable to receive an instruction transmitted from said information processing terminal in response to said notification (Hirota teaches in col. 5, lines

1-6 of an ability of the user to input a command by way of a remote controller. A receiver to receive the output from the remote controller is inherent);

- and a processor operable to process prior contents recorded on the recording medium in accordance with said instruction (Hirota teaches in col. 5, lines 34-58 of a processor 114 that is able to process prior contents recorded on the HDD 119 at the request of the user).

Regarding claim 2, Hirota teaches that the notification includes the titles of programs that are currently stored on the medium (col. 6, lines 16-20). Hirota teaches in col. 5, lines 35-58 of the Hard Disc Drive 119 and more specifically a processor 114 of being able to delete a stored program by way of user notification.

Regarding claim 3, Hirota discloses in col. 4, lines 12-45 that the Hard Disk Drive 119 is capable of performing reserved recording. The Hard Disc Drive 119 by way of interface controller 120 and the transport processor 16 is able to perform reserved recording. Since reserved recording can be performed, a unit to control the unattended recording is inherent. The processor 114 as described in col. 5, lines 7-13, conducts the determination of free space. Hirota teaches in col. 5, lines 14-17 of a process that notifies the user of the free capacity on the medium.

Method claim 5 is rejected along with the same basis as disclosed above in apparatus claim 1.

Regarding claim 7, Hirota teaches of an OSD processor 110 that receives the notification of insufficient free space. The OSD processor 110 then generates a visual display on the display unit, so that the user can acknowledge the notification (col. 5, lines 14-17).

The user is able to give an instruction in reference to the notification of insufficient free space (col. 5, lines 26-29) by way of a remote controller (col. 5, lines 1-6). The remote controller is the equivalent to a transmitter that transmits the instruction. The instruction is then implemented by the processor to free up space on the HDD to allow for new recordings to take place (col. 5, lines 34-58).

Regarding claim 8, Hirota teaches that the notification includes the titles of programs that are currently stored on the medium (col. 6, lines 16-20) and is further displayed on a TV by way of an OSD processor 110 (col. 5, lines 14-20). Hirota teaches in col. 5, lines 35-58 of the Hard Disc Drive 119 and more specifically a processor 114 of being able to delete a stored program by way of user notification.

Regarding claim 9, the OSD processor 110 receives the notification by way of the processor 119, which is part of the integrated receiver decoder (IRD) capable of recording broadcasts (Fig. 1). The remote controller transmits the instruction to the IRD as described in col. 5, lines 1-6.

Method claim 10 is rejected along with the same basis as disclosed above in apparatus claim 7.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hiruta, and further in view of Hanai.

Hiruta teaches in his invention the ability for reserved or unattended recording to take place, but he doesn't expressly disclose the ability for a presetting unit to generate broadcast contents that belong to a genre and further have the ability to preset the broadcast contents to be recorded.

Hanai discloses in his invention of an electronic program guide (EPG) that displays a list of programs that are currently broadcast and future broadcasts as well. The EPG can display programs that belong to certain genres. The user, by way of a remote control 61, that allows the user to schedule recording of programs (col. 5, lines 17-56).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the ability to preset the recording of broadcast programs

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through the EPG to allow the user a more efficient and interactive method of presetting recordings.

5. Claims 6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hitura as applied to above claims 1 and 7, respectively, and further in view of Lang.

Hitura teaches a system that meets all the limitations as set forth by the inventor, but fails to specifically mention a medium recorded with a computer-readable program that includes the instructions for the methods and functions of the claimed invention.

Lang teaches in col. 7, lines 10-19 of memory unit (ROM 32) that stores programs used by a processor (CPU 31). As mentioned in col. 6, lines 46-52, the control unit (DCU 14) uses the programs stored in the ROM 32 to accomplish its' tasks.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a medium recorded with a computer-readable program so that a computer can be used to control any of the functions of the apparatus.

6. Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiruta, and further in view of Breslauer.

Regarding claim 12, Hiruta teaches an apparatus that notifies a terminal, a user, of insufficient free space on a medium when a preset recording needs to take place, but he fails to teach a processing apparatus that relays notifications from one apparatus to another, and transmit instructions from apparatus to another.

Breslauer teaches an apparatus that has a first receiver, a conditional access manager 314 that receives a notification from multimedia manager 306 for a request to view multimedia segments. The notification unit, the conditional access manager 306, is then able to send a second notification acknowledging the receipt of the first notification to another apparatus, conditional access providers 316. The conditional access providers 316 then makes a decision based on the notification from the multimedia manager 306 and sends the decision (instruction) back to the conditional access manager 314; this would suggest that there is a second receiver in the conditional access manager 314. Then, the conditional access manager 314, is then able to transmit to the multimedia manager the instruction as decided by the conditional access providers (col. 8, line 42 – col. 9, line 49).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Breslauer's notification unit into Hiruta's invention to allow for notifications to be relayed from one end to another. Hiruta discloses the motivation to provide a broadcasting receiver that reduces failure of recording ability due to insufficient space, and to promote user's transaction efficiently and effectively. Breslauer's apparatus teaches a relaying system that can be utilized to reach an end user to control recording of broadcast programs.

Claim 13 is met by a combination of Hiruta and Breslauer, wherein Hiruta discloses that the notification includes titles of prior contents (col. 6, lines 16-20). Breslauer teaches of a transmitter transmitting an instruction (col. 9, lines 42-45), and



Hiruta teaches that the instruction is an instruction to delete prior contents (col. 5, lines 26-29).

Method claim 14 is rejected along with the same basis as disclosed above in apparatus claim 12.

Claim 15 is met by the combination of Hiruta and Breslauer, wherein Breslauer discloses that a computer readable media that has instructions for operating the apparatus.

### ***Conclusion***

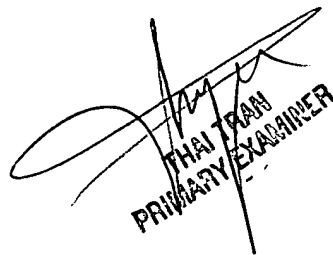
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gelek Topgyal whose telephone number is 517-272-8891. The examiner can normally be reached on 8am -5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gelek Topgyal  
2/2/2006

  
THAI TRAN  
PRIMARY EXAMINER